



**PATENT**

Attorney Docket No.: A-67229-6/RFT/RMS/RMK  
Attorney File No. 463077-00005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DAHIYAT et al.

Serial No. 09/782,004

Filed: February 12, 2001

For: *Protein Design Automation for  
Protein Libraries*

Examiner: Borin, Michael L.

Group Art Unit: 1631

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Mailed: June 29, 2006

Signed: *Victoria Linne Poulsen*  
Victoria Linne Poulsen

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Box Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying substitute for form PTO-1449. Copies of the references are enclosed.

None of the foregoing references are believed to disclose the invention as claimed. Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

07/07/2006 RPIERBRIGHT 00000090 09782004

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03 FC:1806

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1, B3, C3 and C4 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated March 31, 2006, for a counterpart European Patent Application, EP 04015169. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 and B4, listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated March 14, 2006, for a counterpart European Patent Application, EP 04016539. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 28, 2006, for a counterpart European Patent Application, EP 04016943. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 and A2 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 27, 2006, for a counterpart European Patent Application, EP 04015782. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A2, B3, B5, and B6, listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 17, 2006, for a counterpart European Patent Application, EP 02763433. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references B1, B2, B7, B8, B9, C1, and C2, , listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 17, 2006, for a counterpart

Serial No. 09/782,004  
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European Patent Application, EP 04015112. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and as required by M.P.E.P. § 2001.06(b), Applicant notes that the present application is related to the following pending patent applications:

1. U.S.S.N. 09/927,790, filed August 10, 2001;
2. U.S.S.N. 10/101,499, filed March 18, 2002;
3. U.S.S.N. 10/218,102, filed August 12, 2002;
4. U.S.S.N. 10/666,311, filed September 18, 2003; and
5. U.S.S.N. 10/665,307; filed September 18, 2003

Pursuant to 37 C.F.R. §1.97(c), payment by check is enclosed in the amount of \$180.00 as set forth in 37 C.F.R. §1.17(p). Although no further fee is believed to be due, if this belief is in error the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 463077-00005 (A-67229-6 / 463077-0005)).

Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,  
DORSEY & WHITNEY LLP

Dated: 6/29/06  
Customer Number: 32940  
Dorsey & Whitney LLP  
Intellectual Property Department  
555 California Street, Suite 1000  
San Francisco, CA 94104-1513  
Telephone: (415) 781-1989  
Facsimile: (415) 398-3249

BY: Robin M. Silva  
Robin M. Silva, Reg. No. 38,304  
Filed under 37 C.F.R. § 1.34(a)



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Substitute PTO/SB/08A (07-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Substitute for form 1449/PTO  
(Modified)

## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

### Complete if Known

Application Number	09/782,004
Filing Date	February 12, 2001
First Named Inventor	Dahiyat et al.
Art Unit	1631
Examiner Name	Borin, Michael
Attorney Docket Number	Docket 67299-6 463077-5

Sheet 1 of 2

### U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	A1	US-2002-0090648	07-11-2002	Dahiyat et al.	
	A2	US-2003-0049654	03-13-2003	Dahiyat et al.	
	A3	US-2004-0043429 A1	03-04-2004	Dahiyat et al.	
	A4	US-2004-0043430 A1	03-04-2004	Dahiyat et al.	
	A5 ↑	US-5436850	07-25-1995	Eisenberg et al.	
	A6	US-6269312	07-31-2001	Mayo et al.	

### FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>2</sup> Number <sup>3</sup> Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
	B1 ↑	EP 0549107 A	06-30-1993	Syntex Inc.		
	B2 ↑	WO 00/40715 A	07-13-2000	Trustees of Boston University		
	B3 ↑	WO 01/37147 A	05-25-2001	Algonomics NV		
	B4 ↑	WO 01/39098 A	05-31-2001	Yissum Research Development Company of the Hebrew		
	B5 ↑	WO 01/61344 A	08-23-2001	California Institute of Technology		
	B6 ↑	WO 03/006154 A	01-23-2003	Xencor, Inc.		
	B7 ↑	WO 94/16090 A	07-21-2004	Molecular Tool, Inc.		
	B8 ↑	WO 98/05765 A	02-12-1998	Novo Nordisk A/S		
	B9 ↑	WO 98/32845 A	07-30-1998	Bionvent International AB		

### NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	C1 ↑	Cojee et al. "Seamless gene engineering using RNA- and DNA- overhang cloning" <i>Nature Biotechnology</i> , vol. 18, (2000) pps. 1087-0156	
	C2 ↑	Gal J. et al. "Directional Cloning of Native PCR Products with Performed Sticky Ends" <i>Mol. Gen. Genet.</i> Vol. 260, no. 6, (1999), pps. 569-573	
	C3	Koehl P. et al., "De novo protein design I. in search of stability and specificity" <i>J.Mol.Biol.</i> , vol. 293, no. 5, (1999) pps. 1161-1181	
	C4 ↑	Wernisch L. et al. "Automatic protein design with all atom force-fields by exact and heuristic optimization" <i>J. Mol. Biol.</i> Vol. 301, no. 3, (2000), pps. 713-736	

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English Language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the complete application form to the USPTO. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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